

Appl. No. 09/674,691
Atty. Docket No. CM1764Q
Amdt. dated 17 October 2003
Reply to Office Action of 30 July 2003
Customer No. 27752

REMARKS

Claims 1-4, and 6-17 are pending in the present application, claim 15 has been withdrawn. No additional claims fee is believed to be due.

Claim 1 has been amended to more particularly point out the subject matter of the invention. Support for this amendment is found at pages 4 through 6 and pages 9 and 10 of the specification.

Additionally, claim 14 has been amended for clarity and to more distinctly claim the subject matter of the invention.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 112, Second Paragraph

The Office Action rejected claims 1-4, 6-14, 16, and 17 under 35 USC 112, Second Paragraph based on the recitation of "tissue web" in claim 1. The Office Action states that "tissue web" is indefinite because "tissue web can be made from any number of processes" and can be woven or non-woven. The Office Action further states that "the specification sets forth no detail as to how a tissue web is made." Applicants respectfully submit that amended claim 1 and the accompanying remarks overcome this rejection.

Applicants have amended claim 1 to recite that the "web is selected from fibrous webs, films and foams and laminates thereof." Fibrous webs is discussed in the specification at least on page 5 where examples of fibrous webs, "such as a tissue web, a non-woven web, a woven web, a knit web, or the like," are provided. Applicants further assert that one of ordinary skill in the art, based on the description provided in the specification, would understand the scope of the term "fibrous webs." The fact that the term "fibrous webs" is broad enough to encompass more than one material does not in itself make the limitation indefinite, as a claims breadth does not necessarily affect its definiteness. MPEP §2173.04. Accordingly, Applicants request withdrawal of the rejection under 35 USC 112, Second Paragraph.

Rejection Under 35 USC 102(c)/103(a) Over Weder

Claims 1-4, 6-13, 16, and 17 were rejected under 35 USC 102(e) or, in the alternative, under 35 USC 103(a) over Weder (US 6,151,830). The Office Action states as the basis for these rejections that "Weder discloses a sleeve material that comprises a plurality of folds that are

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connected by an adhesive or cohesive bonding material.” And that the “folds acts as an expansion means when the sleeve material needs to have a greater length, while the connecting material constricts the expansion of the folds when the expansion is not needed.” The Office Action then states that the required property limitations are inherent in, or, in the alternative, obvious from Weder’s disclosure. While Applicants agree with the characterization of Weder in that the folds act as expansion means and the connecting material constricts expansion, Applicants respectfully traverse the rejections.

Initially, Applicants aver that Weder fails to disclose, teach, or suggest a “web material having a longitudinal dimension and a transverse dimension substantially smaller than said longitudinal dimension” as required by the claims. The Office Action failed to specify where in Weder this limitation is taught and it is not apparent from a reading of Weder. Weder is directed to a floral sleeve; the Office Action characterized Weder as disclosing “a sleeve material” and does not address whether the sleeve material has a transverse dimension substantially smaller than the longitudinal dimension. In fact, the Office Action fails to indicate which is the longitudinal and which are the transverse directions in Weder’s floral skirt. Because Weder’s folds allow circumferential expansion, Applicants presume that the Office Action interpreted Weder’s skirt to have a transverse dimension equal to the height of the skirt and a longitudinal dimension equal to the circumferential dimension of the skirt. However, even with this presumption, Weder fails to disclose, teach, or suggest a transverse dimension that is substantially smaller than a longitudinal dimension.

Weder fails to discuss the relatively sizes of the skirt’s height and circumference in the specification. Therefore, the only disclosure available in Weder on this point is found in the figures. It is well settled that drawings and pictures can be used as prior art. MPEP §2125. However, in order for a drawing or picture to anticipate a claim, the drawing or picture must clearly show the claimed structure. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). All of the claimed structural features and how they are put together, must be shown by the picture as well. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). However, where “the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” MPEP §2125 (citing *Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000)). The drawings and the description combined can be relied on “for what they would reasonably teach one of ordinary skill in the art.” *Id.* (citing *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977)).

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The figures in Weder consistently show a floral sleeve having a height visually represented as being larger than the radius. Because Weder's sleeve is frustoconical, it does not have a single circumferential dimension. However, regardless of the location along the height of the sleeve, the circumferential, or longitudinal, dimension does not appear in the figures to be substantially larger than the height, or transverse dimension as required by the claims in present application. Weder fails to disclose "a web material having a longitudinal dimension and a transverse dimension substantially smaller than said longitudinal dimension." Accordingly, Applicants traverse the rejection under 35 USC 102(e) because Weder fails to disclose a required claim limitation.

Additionally, Applicants traverse the rejection under 35 USC 102(e) and under 35 USC 103(a). The Office Action states that

"it is reasonable to presume that said limitations (Relative Expansion Tension Reduction, Discontinuous Expansion Threshold, Discontinuous Expansion Point, elongation at Tearing Point, and Contraction Force) are inherent to the invention of Weder. Support for said presumption is found in the use of similar materials (i.e. nonwoven webs or films as the web material) and in the similar production steps (i.e. adhesively joining folds in the web material that are designed to fracture) used to produce the sleeve."

While "the express, implicit, and inherent disclosures of a prior art reference may be relied upon in a rejection..., the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP §2112. Furthermore, the MPEP states that "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP §2112 (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

Applicants respectfully traverse the characterization of the Weder reference that is asserted as support for the presumption of inherency. Specifically, the Office Action states that Weder's sleeve is made by adhesively joining the folds in the web material such that the joins are intended to fracture. However, Weder does not disclose, teach, or suggest the use of connecting material that is "designed to fracture." In fact, the opposite is true. "The connected portion 44 functions to constrict the expansion of the folds 40 of the upper end 37 of the base portion 36 when a pot is disposed within the sleeve, thereby causing the skirt portion 38 to extend at an angle, for example, outwardly, from the base portion 36 of the sleeve 10...." Weder '830, col. 9, lines 29-35. Weder also teaches that the expansion of the sleeve is intended to allow the sleeve to conform to the circumference of a pot placed therein. Weder '830, col. 9, lines 2-5. The

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connected portion of Weder is not intended to fracture as stated in the Office Action because such fracture would defeat the purpose of the connected portion (causing the skirt portion to extend at an angle). Weder does not teach the use of a tearable expansion obstruction means and actually teaches away from such use. Accordingly, Applicants aver that the presumptions underlying the inherency arguments in the Office Action are not supported by the disclosure of Weder and the characteristics asserted to be inherent in Weder do not necessarily flow from Weder's disclosure. Applicants respectfully submit that a *prima facie* case of anticipation based on inherency has not been made in the Office Action.

Additionally, Applicants submit that the Office Actions to date have failed to make out a *prima facie* case of obviousness under 35 USC 103. MPEP §2142 sets forth the requirements for a *prima facie* case:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2142 (quoting *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)). Weder fails to expressly or impliedly disclose, teach, or suggest web material according to the present invention with a transverse dimension substantially smaller than the longitudinal dimension and with a tearable expansion obstruction means. Furthermore, the Office Action failed to "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of [Weder]." See MPEP §2142. Moreover, Weder actually teaches away from a web material with a longitudinal expansion means and a tearable expansion obstruction means. Accordingly, Applicants respectfully submit that the Office Action has not met the initial burden of establishing a *prima facie* case. Applicants request withdrawal of the rejection under 35 USC 103.

Rejection Under 35 USC 102(b)/103(a) Over Delmar

Claims 1-4, 6-14, 16, and 17 have been rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over Delmar (US Pat. 3,785,406). Applicants respectfully submit that the present amendments to Claim 1 overcome these rejections.

The Office Action correctly states that Delmar's "bonds are created by heat-sealing the plastic." Additionally, Delmar teaches that the "folds can also be separably secured by a suitable cement or adhesive for the plastic from which the tube is made." However, Delmar does not disclose the use of cohesive bonding, pressure bonding, friction bonding, autogenous bonding,

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mechanical fixation, or combinations thereof as required by the present claims. Accordingly, Applicants respectfully submit that Delmar does not anticipate the present claims and requests withdrawal of the rejection under 35 USC 102(b).

Additionally, Applicants submit that the Office Action failed to make out a prima facie case of obviousness under 35 USC 103 with respect to the presently amended claims. MPEP §2142 sets forth the requirements for a prima facie case:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2142 (quoting *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)). Delmar fails to expressly or impliedly disclose, teach, or suggest a tearable expansion obstruction means selected from cohesive bonding, pressure bonding, friction bonding, autogenous bonding, mechanical fixation, or combinations thereof. Furthermore, the Office Action failed to "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of Delmar." See MPEP §2142. Moreover, Delmar provides no suggestion or motivation to modify the heat seal, concrete or adhesive taught therein. Accordingly, Applicants respectfully submit that the Office Action has not met the initial burden of establishing a prima facie case. Applicants request withdrawal of the rejection under 35 USC 103(a).


Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC §§102, 103 and 112. Early and favorable action in the case is respectfully requested. Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-4, 6-14, 16 and 17.

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